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**UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION**

In re) Case No. 05 CV 01114 JW
ACACIA MEDIA TECHNOLOGIES) MDL No. 1665
CORPORATION)
) **NOTICE OF COMPLIANCE BY ACACIA**
) **WITH CASE MANAGEMENT ORDER**
) **NARROWING DISPUTED CLAIMS**

1 TO ALL PARTIES AND TO THE COURT:

2 PLEASE TAKE NOTICE that Acacia has complied with the Court-ordered stipulation of the
3 parties and has notified defendants of further patent claims it will not assert in this litigation, thereby
4 mooting a substantial number of motions which the defendants propose to file.

5 A copy of the letter sent to all counsel is attached to this Notice.

6

7 Dated: May 16, 2008

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11 By _____ /S/ Roderick G. Dorman
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May 16, 2008

VIA E-MAIL

TO ALL COUNSEL OF RECORD

**Re: *In re Acacia Media Technologies*
No. C 05-1114 (MDL 1665)**

Dear Counsel:

As you are aware, Acacia initially asserted the following claims against one or more defendants:

- Claims 1-24, 41-49, and 51-53 of U.S. Patent No. 5,132,992 (the '992 patent);
- Claims 2 and 5 of U.S. Patent No. 5,253,275 (the '275 patent);
- Claims 14-19 of U.S. Patent No. 5,550,863 (the '863 patent);
- Claims 4, 6-8, and 11 of United States Patent No. 6,002,720 (the '720 patent); and
- Claims 1-42 of U.S. Patent No. 6,144,702 (the '702 patent).

During the claim construction phase of the case, Acacia withdrew claims 1-18 of the '992 patent with respect to the Internet defendants and withdrew claims 23, 24, 47, 48, 49, 51, 52, and 53 of the '992 patent with respect to all defendants. Acacia provided stipulated covenants not to sue on each of those claims.

Recently, in response to defendants' lists of proposed Section 112 motions and based on the Court's claim construction rulings, Acacia stated that it would not oppose defendants' proposed motion nos. 1, 2, 3, 5, and 10-12 of Mr. Benyacar's March 28 letter

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and proposed motion nos. 1 and 4 of Mr. Kreeger's March 28 letter. As a result, all of the claims asserted by Acacia are invalid, based on the Court's constructions, as evidenced by Acacia's stipulation of April 4.

At the May 9 Case Management Conference, the Court directed Acacia to determine whether it could eliminate as many of the remaining proposed section 112 motions as possible. Accordingly, pursuant to the Court's direction, Acacia will withdraw the following claims and will provide defendants with a covenant not to sue on such claims:

- Claims 19-22 and 42-44 of the '992 patent;
- Claims 2 and 5 of the '275 patent;
- Claims 14-16 of the '863 patent; and
- Claims 4 and 6-8 of the '720 patent.

We will provide you with a stipulated covenant not to sue on these claims in the same form that we previously have jointly executed. Further, we will provide a new form of Stipulated Covenant Not to Sue and Order Thereon to conform to the requirements of the Order to be included with the stipulation prescribed by the Court at our last hearing for both these patent claims and those contained in the earlier stipulation.

The withdrawal of these claims by Acacia reduces the number of proposed Section 112 motions which remain in dispute. It is our understanding that the following proposed Section 112 motions are mooted by Acacia's withdrawal of the above-identified claims: Proposed Motion Nos. 6, 13, 18, 22, 27, 28, 29, 30, 31, 34, and 35 of Mr. Benyacar's March 28 letter.

Thus, at this time, only the following proposed Section 112 motions remain in dispute:

- Proposed Motion Nos. 4, 7, 8, 9, 14, 15, 16, 17, 19, 20, 21, 23, 24, 25, 26, 32, and 33 of Mr. Benyacar's March 28 letter; and
- Proposed Motion Nos. 1, 2, 4, 5, and 6 of Mr. Kreeger's April 11 letter. (note that Mr. Kreeger changed the identifying number of each of his proposed motions between his March 28 letter and his April 11 letter).

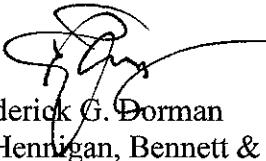
Acacia's withdrawal of these claims is done without prejudice to Acacia bringing a motion for summary judgment under Rule 56(a) that all of the currently asserted claims are invalid based on the Court's claim constructions; without prejudice to Acacia's contentions that all of defendants' counterclaims and the issues presented in the remaining, listed motions of Messrs. Benyacar and Kreeger are moot in light of Acacia's stipulation that all of the asserted patent claims are invalid; and without prejudice to Acacia seeking a final judgment that all of the asserted claims are invalid based on the Court's claim construction and dismissing without prejudice defendants' counterclaims, as Acacia set forth in its

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portion of the Joint Case Management Statement and at the Case Management Conference
on May 9.

Very truly yours,



Roderick G. Dorman
of Hennigan, Bennett & Dorman LLP

RGD:APB:csy

PROOF OF SERVICE-UNITED STATES DISTRICT COURT

I am employed in the County of Los Angeles, State of California. I am over the age of 18 years and not a party to the within action; my business address is 865 South Figueroa Street, Suite 2900, Los Angeles, California 90017.

On May 16, 2008, I served a copy of the within document(s) described as **NOTICE OF COMPLIANCE BY ACACIA WITH CASE MANAGEMENT ORDER NARROWING DISPUTED CLAIMS** on the interested parties in this action by transmitting via United States District Court for the Northern District of California Electronic Case Filing Program the document listed above by uploading the electronic files for each of the above listed document(s) on this date, addressed as set forth on the attached Service List.

The above-described document was also transmitted to the parties indicated below, by Federal Express only.

Chambers of the Honorable James Ware
Attn: Regarding Acacia Litigation
280 South First Street
San Jose, CA 95113
3 copies

I am readily familiar with Hennigan, Bennett & Dorman LLP's practice in its Los Angeles office for the collection and processing of federal express with Federal Express.

Executed on **May 16, 2008**, at Los Angeles, California.

I declare that I am employed in the office of a member of the bar of this court at whose direction the service was made.

/S/ Carol S. Yuson
Carol S. Yuson

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